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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,997	04/13/2004	Geoffrey B. Rhoads	P0975	4999

23735 7590 11/27/2007

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER	
RICE, ELISA M	

ART UNIT	PAPER NUMBER
2624	

MAIL DATE	DELIVERY MODE
11/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,997	RHOADS ET AL.	
	Examiner	Art Unit	
	Elisa M. Rice	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33, 34, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Philyaw et al. (US 6098106).

As per claim 33, Philyaw discloses a portable wireless device that includes a sensor to capture image or audio data, a method comprising:

capturing audio in the device to provide an audio signal (col. 3, lines 19-20, 24-26);

at least partially extracting a data from the captured audio from the audio signal (col. 13, line 60 to col. 14, line 5 where the data in the form of advertiser URL serving to identify

corresponding content stored in a repository (website));

wirelessly transferring the extracted data to a remote location(col. 13, 1. 65-col. 14, 1.5); and wirelessly receiving data corresponding to the extracted data from the remote location(col. 8, lines 11-12).

As per claim 34, Philyaw discloses the method of claim 33 wherein the data corresponding to the extracted data comprises a higher fidelity version of the audio (col. 13, line 60 to col. 14, line 5). Higher fidelity equipment has lesser amounts of noise and distortion and so the program that the user will hear broadcast from the advertiser's website will be of higher fidelity in that it does not contain any embedding which distorts albeit slightly the quality of the audio.

As per claim 40, Philyaw discloses the method of claim 34 including: substituting the higher fidelity version for at least a part of the captured data to create a new data object; and rendering the new data object on an output device (col. 13, line 60 to col. 14, line 5). Higher fidelity equipment has lesser amounts of noise and distortion and so the program that the user will hear broadcast from the advertiser's website on their PC, the output device, will be of higher fidelity in that it does not contain any embedded tone which distorts albeit slightly the quality of the audio from the tv broadcast.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 35-39 and 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philyaw et al. (US 6098106) and Zhao et al. (US 6243480).

As per claim 35, Philyaw discloses the method of claim 33 but does not disclose wherein the extracted data is obtained from a digital watermark steganographically embedded in the audio signal.

Although Philyaw teaches that the data is encoded and/or embedded (col. 6, 11. 15-16, col. 9, 11.37-42, col. 9, 11. 52-54, col. 10, 11.34-36), Philyaw does not teach that the data is watermark data. However, Zhao teaches such features at col. 11, line 26 to col. 12, line 13. Zhao teaches that an active watermark is an embedded program that the watermark decoder decodes and then implements on the computer hosting the decoder (col. 11, lines 40-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Philyaw to utilize the active watermarks of Zhao because

watermarking is a well-known technique for increasing "security" (Zhao, column 1, line 16).

As per claim 36, Philyaw discloses the method of claim 33 further including indexing a database with reference to at least a portion of the decoded digital data (advertiser's url address) from the audio signal to obtain information corresponding to the audio signal, and returning the information to the portable wireless device (col. 13, line 60 to col. 14, line 5).

Philyaw does not disclose indexing a database (Rhoads, numbers 1-256 serve as an index, page 120, lines 1-5) with reference to at least a portion of a digital watermark decoded from the audio signal (page 121, lines 18-20).

Although Philyaw teaches that the data is encoded and/or embedded (col. 6, 11. 15-16, col. 9, 11.37-42, col. 9, 11. 52-54, col. 10, 11.34-36), Philyaw does not teach that the data is watermark data. However, Zhao teaches such features at col. 11, 1.26-col. 12, 1. 13. Zhao teaches that an active watermark is an embedded program that the watermark decoder decodes and then implements on the computer hosting the decoder col. 11, 11.40-48.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Philyaw to utilize the active watermarks of Zhao because

watermarking is a well-known technique for increasing "security" (Zhao, column 1, line 16).

As per claim 37, the combination of Philyaw and Zhao discloses the method of claim 36 which further includes indexing a database with reference to at least a portion of the decoded watermark to obtain a computer address corresponding thereto, and receiving content data from said computer address at the destination device (see rejection of claim 36 for the specific citations to Philyaw and Zhao that these limitations).

As per claim 38, the combination of Philyaw and Zhao discloses the method of claim 37 in which the destination device is co-located with the portable device (Philyaw, col. 13, line 60 to col. 14, line 5).

As per claim 39, the combination of Philyaw and Zhao discloses the method of claim 38 in which the destination device comprises the portable device (Philyaw, col. 13, line 60 to col. 14, line 5).

As per claim 41, Philyaw discloses the method comprising:

capturing image(col. 10, lines 33-48) or audio data(col. 3, lines 19-20, 24-26); the [data] (advertiser URL) serving to identify corresponding content stored in a repository (website) (col. 13, 1.60-66));

transferring the data to a remote device (col. 13, 1. 65-col. 14, 1.5); and

receiving data from the remote device based on the data (col. 8, lines 11-12).

Although Philyaw teaches that the data is encoded and/or embedded (col. 6, 11. 15-16, col. 9, 11.37-42, col. 9, 11. 52-54, col. 10, 11.34-36), Philyaw does not teach that the data is watermark data. However, Zhao teaches such features at col. 11, 1.26-col. 12, 1. 13. Zhao teaches that an active watermark is an embedded program that the watermark decoder decodes and then implements on the computer hosting the decoder col. 11, 11.40-48. Zhao goes on to teach that the instruction data sent with the content could be: access permission (col. 11, 11.65-66) and the period of time for which a digital representation can be used (col. 12, 11. 10-13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Philyaw to utilize the active watermarks of Zhao because watermarking is a well-known technique for increasing "security" (Zhao, column 1, line 16).

As per claim 42, the combination of Philyaw and Zhao discloses the method of claim 41, wherein the digital audio device comprises a wireless telephone (Philyaw, col. 13, lines 53-57).

As per claim 43, the combination of Philyaw and Zhao discloses the method of clairn 41, wherein said transferring comprises wirelessly transferring (Philyaw, Fig. 3).

As per claim 44, Philyaw discloses a wireless device comprising:

a wireless transmitter and receiver (Fig. 1. num. 110 and 114);

a sensor to capture image (col. 10, lines 33-48) or audio data (col. 3, lines 19-20, 24-26;

said transmitter for sending the auxiliary data to a remote device (col. 13, 1. 65-col. 14, 1.5) and receiving corresponding data from the remote device (col. 8, lines 11-12).

As per disclosing a steganographic decoder for discerning auxiliary data steganographically embedded in data received by the device, although Philyaw teaches that the data is encoded and/or embedded (col. 6, 11. 15-16, col. 9, 11.37-42, col. 9, 11. 52-54, col. 10, 11.34-36), Philyaw does not teach that the data is steganographically embedded data. However, Zhao teaches such features at column 11, line 26 to column 12, line 13. Zhao teaches that an active watermark is an embedded program that the watermark decoder decodes and then implements on the computer hosting the decoder (Zhao, col. 11, lines 40-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Philyaw to utilize the active watermarks of Zhao because

watermarking is a well-known technique for increasing "security" (Zhao, column 1, line 16).

As per claim 45, the combination of Philyaw and Zhao discloses the wireless device of claim 44, wherein said wireless device comprises a wireless telephone (Philyaw, col. 13, lines 53-57).

As per claim 46, the combination of Philyaw and Zhao discloses the wireless device of claim 44, wherein said steganographic decoder comprises instructions executing on a processor (Zhao, col. 11, lines 40-48).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elisa M. Rice whose telephone number is (571)270-1582. The examiner can normally be reached on 8:00a.m.-5:30p.m. EST Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian P. Werner can be reached on (571)272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elisa Rice ER 11/23/2007
Patent Examiner
2624

EMR

BRIAN WERNER
SUPERVISORY PATENT EXAMINER